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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,490	06/28/2001	Robert Everett Parkhill	77666-10/jlo	3152

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EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,490

Applicant(s)

PARKHILL ET AL.

Examiner

Ponnoreay Pich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/19/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-16 have been examined and are pending.

Information Disclosure Statement

The IDS submitted by the applicant has been considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 7, 8, 11, 13, 14, and 15 use the term "assertion." Neither the applicant's specification nor the claims themselves explicitly define what the applicant's definition of assertion is. However, for the purpose of examining this application, the examiner will apply the broadest reasonable interpretation to "assertion" to have assertion mean "anything which affirms something else, which can include a public key certificate." Any claim not specifically address are rejected by virtue of dependency. Appropriate action is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 and 15-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1:

Claim 1 refers to a method of providing assertion comprising:

1. Selling a pool of unallocated time, which is disclosed in the applicant's specification as handled by a purchase component 18 (p8, lines 15-19).
2. Generating an assertion upon request, which is disclosed in the applicant's specification as handled by a request component 20 and a Certificate Authority (CA) server 28 (p9, lines 5-9 and 26-32).
3. Revoking an assertion upon request, which is disclosed in the applicant's specification as handled by a revocation component 22 (p10, lines 13-16).

The purchase component, request component, and revocation component are disclosed in the applicant's specification as being subroutines within the Certificate Time Manager (CTM) software (page 6, lines 8-12). No tangible subject matter is disclosed by any of these components. In addition, the examiner notes that the CA server may be a software server. Also, applying the broadest reasonable interpretation to the claim, claim 1 is broad enough to cover a method which is not implemented with the technological arts.

Claim 2:

Claim 2 has all the limitations of claim 1. In addition, claim 2 refers to a further step of eroding unallocated time over time. The applicant's specification discloses this

step as being handled by the CTM component (p11, lines 30-31). The CTM software is just software, so no tangible subject matter is recited (p6, lines 9-10).

Claim 3:

Claim 3 refers to purchase, request, and revocation components. As disclosed in claim 1, these components are software and are not tangible subject matters. In addition, claim 3 also refers to a repository, which the applicant discloses is a public database (page 2, lines 16-18). Databases are just software. No tangible subject matter is recited in claim 3.

Claim 4:

Claim 4 has all the limitations of claims 3. In addition, the examiner notes that certificates are stored in repositories (i.e. databases), which is just software, see p6, lines 22-24. No tangible subject matter is recited.

Claim 5:

Claim 5 has all the limitations of claim 3. In addition, claim 5 refers to monitoring when the unallocated time falls below a threshold and notifying a user associated with the unallocated time if the unallocated time falls below the threshold. Monitoring and notification are disclosed as being handled by the CTM software (p 13, lines 2-5). No tangible subject matter is recited.

Claim 6:

Claim 6 has all the limitations of claim 3. In addition, claim 6 refers to the request component determining whether the requested lifetime is greater than the unallocated time, and if the requesting lifetime is greater than the unallocated time, presents the

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user with a set of options for remedying an insufficiency of the unallocated time. This limitation is disclosed in the applicant's specification as being implemented by the request component (p9, lines 13-15 and p10, lines 1-5). As discussed in claim 1, the request component is just software, so no tangible subject matter is recited.

Claims 7 and 11:

The steps of claim 7 and 11 are disclosed in the claims as being implemented by a processing platform. A processing platform is defined as "the underlying hardware or software for a system." Thus, the examiner asserts that claim 7 given its broadest reasonable interpretation reads on just software—an operating system.

Claims 8-10 and 12:

Claims 8-10 have all the limitations of claim 7. Claim 12 has all the limitations of claim 11. In addition, as per claims 8-10 and claim 12, the examiner asserts that only additional steps performed by the software on the data being processed are recited.

Thus no statutory subject matter is recited.

Claim 13:

"Functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. The definition of "data structure" is a "physical or logical relationship among data elements, designed to support specific data manipulation functions." (The Authoritative Dictionary of IEEE Standards Terms, 7th Edition) "Nonfunctional descriptive material" includes but is not limited to music, literary works and compilation or mere arrangement of data.

The examiner asserts that the invention as recited in claim 13 imparts no functionality when employed as a computer component but rather is a mere arrangement of data.

Claim 15:

Claim 15 discloses a system with means for:

1. Allocating a pool of unallocated time, which is disclosed in the applicant's specification as handled by a purchase component 18 (p8, lines 15-19).
2. Processing a request for an assertion, which is disclosed in the applicant's specification as handled by a request component 20 and a Certificate Authority (CA) server 28 (p9, lines 5-9 and 26-32).
3. Processing a revocation, which is disclosed in the applicant's specification as handled by a revocation component 22 (p10, lines 13-16).

As discussed in claim 1, these components are software only and no tangible subject matter is recited. Note also that applying the broadest reasonable interpretation to claim 15, the claim is broad enough to cover a system which is not implemented with the technological arts.

Claim 16:

Claim 16 has all the limitations of claim 15. In addition, claim 16 discloses a means for monitoring unallocated time and for notifying a user. As discussed in claim 5, the means for monitoring and notifying are handled by the CTM software and thus no tangible subject matter is recited. Applying the broadest reasonable interpretation to

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claim 16, the claim is broad enough to cover a system which is not implemented with the technological arts.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward et al (WO 97/30421).

Claim 1:

Ward discloses a method of providing assertions comprising the steps of:

1. Selling a pool of unallocated time (page 2, lines 15-18).
2. Upon request, generating an assertion having a lifetime and subtracting the lifetime from the unallocated time (page 4, lines 4-8).
3. Upon request, revoking an assertion and adding any remaining lifetime of the assertion to the unallocated time (page 2, lines 18-22).

Note that in Ward's invention, the assertion is some sort of indication that a car is legally parked in a metered spot.

Claim 2:

Ward discloses all the limitations of claim 1. In addition, Ward discloses eroding unallocated time over time (page 4, lines 4-8). Note that unallocated time being eroded

away due to it being allocated to a lifetime of the assertion is still the unallocated time being eroded away time over time.

Claim 15:

Ward discloses a system for allocating assertions comprising:

1. Means for allocating a pool of unallocated time available for assertion validity (page 2, lines 15-18).
2. Means for processing a request for an assertion having a lifetime, the means for processing the request subtracting the lifetime from the unallocated time (page 4, lines 4-8).
3. Means for processing a revocation of an existing assertion by determining any remaining lifetime of the existing assertion and adding at least a portion of the remaining lifetime of the assertion to the unallocated time (page 2, lines 18-22).

Claim 16:

Ward discloses all the limitations of claim 15. In addition, Ward further discloses means for monitor when the unallocated time falls below a threshold, and for notifying a user associated with the unallocated time if the unallocated time falls below the threshold (Figure 3, step 265 and 267).

Allowable Subject Matter

Claims 3-14 contain allowable subject matter and would be allowed if the applicant amends the claims to overcome the examiner's 112, second paragraph and 101 rejections.

As per claims 3-14, the examiner was able to find separate prior arts which disclosed features of the claims. However, the examiner was unable to find any motivation which was disclosed or suggested in any of the prior art for which one of ordinary skill in the art would have to combine the teachings of the prior arts to arrive at the applicant's invention. In particular, there were many prior art in the field of computer security which taught the concepts of assertions in the form of public key certificates with a lifetime and which could be revoked. However, there were no teachings in the computer security prior arts which taught of a pool of unallocated time and subtracting the lifetime of a service (i.e. an assertion) from the pool of unallocated time. The examiner did find prior art dealing with car parking meters which taught this limitation. However, these two fields are not analogous art and the examiner was unable to find any motivation suggested in art found in either of these fields which one of ordinary skill would have to combine the teachings of the concepts in these two fields to arrive at the applicant's invention as per claims 3-14.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Hsu et al (US 5,982,898) discloses a certification process wherein the certificates have a limited lifetime and can be revoked at any time.
2. Risafi et al (US 6,473,500) discloses a system and method for using a prepaid card.


3. Wasserman et al (US 6,304,969) discloses a verification server.
4. Bellosguardo (US 2001/0049655) discloses anonymous credit cards.
5. Sachs (US 6,240,397) discloses electronic gift certificates.
6. Berthon et al (US 4,876,540) discloses a system for metered parking.
7. Tibbenham ("Implementing a Pre-payment System", pages 251-257, IEE May 1999) discloses a prepayment system for utilities.
8. Currie ("A Better Way to Prepay College", p25, New York Times December 3, 1989) discloses college tuition prepayment.
9. Asay et al (US 5,903,882) discloses certificate authorization in electronic transactions.
10. Wray et al (US 6,442,696) discloses client identification system.
11. Anderson et al (US 6,609,200) discloses a system for processing electronic documents.
12. Roberts et al (WO 01/11857) discloses prepaid phone service.
13. Sklarewitz ("Wild Wadi Waterpark Exceeds Expectations Early in Season", p16, Amusement Business v112, n24) discloses a prepaid cashless waterpark.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP


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